

1 James L Phillips  
2 MILLER NASH LLP  
3 601 Union St  
4 4400 Two Union Square  
5 Seattle , WA 98101-2352  
6 206-622-8484  
7 Fax: 622-7485  
8 Email: James.Phillips@millernash.com

HONORABLE RICHARD A. JONES

9 Daniel J. O'Connor (*pro hac vice*)  
10 Edward K. Runyan (*pro hac vice*)  
11 Daniel A. Tallitsch (*pro hac vice*)  
12 BAKER & MCKENZIE LLP  
13 130 E. Randolph Street  
14 Chicago, IL 60601  
15 Telephone: +1 312 861 8000  
16 Facsimile: +1 312 861 2899  
17 Daniel.O'Connor@bakermckenzie.com  
18 Edward.Runyan@bakermckenzie.com  
19 Daniel.Tallitsch@bakermckenzie.com

20 Attorneys for Defendant, NINTENDO CO., LTD.

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14 UNITED STATES DISTRICT COURT  
15 WESTERN DISTRICT OF WASHINGTON  
16 AT SEATTLE

17 RECOGNICORP, LLC,

Case No. CV 12-1873-RAJ

18 Plaintiff,

NINTENDO'S MOTION TO STRIKE  
19 INFRINGEMENT CONTENTIONS AND  
20 TO RELIEVE NINTENDO OF  
21 DISCOVERY OBLIGATIONS;  
22 MEMORANDUM OF POINTS AND  
23 AUTHORITIES IN SUPPORT THEREOF

24 NINTENDO CO. LTD.,

**NOTE ON MOTION CALENDAR:**  
**April 5, 2013**

25 Defendant.

26

NINTENDO'S MOTION TO STRIKE INFRINGEMENT CONTENTIONS  
AND TO RELIEVE NINTENDO OF DISCOVERY OBLIGATIONS . . . - 1  
Case No. (CV 12-1873-RAJ)

SEADOCS:455090.1

**MILLER NASH LLP**  
ATTORNEYS AT LAW  
T: (206) 622-8484 S: (206) 622-7485  
4400 TWO UNION SQUARE  
601 UNION STREET  
SEATTLE, WASHINGTON 98101

## **MEMORANDUM OF POINTS AND AUTHORITIES**

## I. INTRODUCTION

Nintendo moves this Court to strike RecogniCorp, LLC's Infringement Contentions (ICs) for failure to comply with L.P.R. 120. All of RecogniCorp, LLC's ICs fail to identify "specifically where each limitation of each asserted claim is found within each Accused Instrumentality" as required by the Rules. L.P.R. 120(c).

## II. FACTS AND BACKGROUND

#### A. The Parties

Plaintiff RecogniCorp, LLC ("RecogniCorp") is headquartered in Round Rock, Texas. It was formed on November 14, 2011, approximately one month before this case was filed. On information and belief, RecogniCorp neither makes nor sells any products. On information and belief, RecogniCorp was formed solely for the purpose of filing suits for patent infringement.

Defendant Nintendo Co., Ltd. ("NCL" OR "Nintendo") is a Japanese company which makes and sells home and personal entertainment products including video and electronic games and related devices. Nintendo of America Inc. ("NOA") is a Washington corporation, headquartered in Redmond, Washington. NOA is a wholly owned subsidiary of NCL. NOA is the exclusive North American distributor of products made by NCL.

## B. The Accused Products

This is a case for alleged patent infringement. The products accused of infringement are described in the Complaint as: "Nintendo composite image customization products that infringe the '303 Patent include, but are not limited to, software included on the Nintendo Wii to create and customize a facial (or other) feature of a Mii". Complaint, ¶ 15.

### C. The Patents-In-Suit -- The Significance of "Coding" and "Codes" in Creating Composite Images

The patent-in-suit is U.S. Pat. No. 8,005,303 ("the '303 patent"), entitled "Method/Apparatus for Encoding/Decoding Image Data". The Abstract summarizes the subject matter of the '303

1 patent as follows: "The invention relates to a method and an apparatus for encoding images,  
 2 more particularly to an encoding unit in conjunction with a library of pictorial entities and image  
 3 qualifiers. The method and apparatus provide for encoding an image by using a code factor table  
 4 in conjunction with a set of element codes. The resulting image code allows the set pictorial  
 5 elements of an image and their associated image qualifiers to be represented by a compact code  
 6 uniquely representing a given configuration of pictorial elements. The use of the resulting image  
 7 code facilitates the transmission and storage of images requiring only the code to be sent or  
 8 stored. The invention further provides a computer readable medium comprising a program that  
 9 direct a computer to implement the encoding process."

10 As can be seen from the Abstract, and from the title of the patent, "codes", and related  
 11 concepts such as "code factors," are central to the '303 patent. Indeed, each claim of the '303  
 12 patent includes multiple limitations calling for "codes" or "code factors" of some sort.  
 13 Independent claim 1 requires: "facial feature element codes"; a "composite facial image code;  
 14 and a "facial feature element code". Independent claim 16 requires: "facial feature element  
 15 codes", a "composite image code", a "facial feature element code", and a "composite image  
 16 code." Independent claim 23 requires "facial feature element codes", a "composite image code",  
 17 and a "facial feature element code". Independent claim 23 requires "facial feature element  
 18 codes", and a "composite image code". Independent claim 29 requires "facial feature element  
 19 codes", a "composite facial image code", and a "facial feature element code". Independent claim  
 20 36 requires "facial feature element codes", and a "composite image code".

21 The specification of the '303 patent states, in the "Field of the Invention": "This  
 22 invention relates to a method and apparatus for encoding/decoding image data..." The prior art  
 23 discussed in the specification pertains to creating composite images of faces, using such features  
 24 as hair, eyes, nose, mouth, and chin. Exh. 1, Col. 1, ll. 36-41. The specification states that, in  
 25 the prior art, composite facial images were made using paper strips containing exemplary  
 26 features that are arranged to form a composite drawing of a face. Exh. 1, Col. 1, ll. 41-43. A use

1 cited is for law enforcement. Exh. 1, Col. 1, ll. 34. In the prior art as discussed in the patent,  
 2 creating a composite facial image was also done by use of a computer that allowed a user to  
 3 select individual components, such as eyes or noses, and combining them on a pre-selected face.  
 4 Exh. 1, Col. 1, ll. 43-46.

5 According to the specification, the patent is about reducing memory and bandwidth  
 6 requirements for the storage and transmission of composite (facial) images by using a "new"  
 7 encoding system. The patent states that a drawback of the prior art systems is that storage of the  
 8 images required "significant amounts of memory." Exh. 1, Col. 1, ll. 60-61. If the images are  
 9 compressed so as to require less memory, their quality is degraded. Exh. 1, Col. 2, ll. 1-4. The  
 10 size and quality of the images is important particularly when they are transmitted from one site to  
 11 another, for example from one police station to another to share information about a given  
 12 suspect. Exh. 1, Col. 2, ll. 4-9. The need that is identified in the prior art, that is allegedly met  
 13 by the '303 patent, is "to refine the process of encoding images" so as to reduce the memory  
 14 requirements and the bandwidth required for the transmission of the images. Exh. 1, Col. 2,  
 15 ll. 9-13.

16           **D. RecogniCorp's ICs Do Not Identify Where Each Limitation Is**  
 17           **Allegedly Found In Each Accused Product.**

18           **1. RecogniCorp's Claim Charts For The '303 Patent Do**  
 19           **Not Show Where Any "Codes" or "Code Factors" Of**  
              **Each Accused Instrumentality Are Allegedly Found.**

20           As discussed above, "codes" and "code factors" are central to the '303 patent and are  
 21 found throughout the claims. RecogniCorp's ICs fail to comply with L.P.R. 120 with respect to  
 22 any of the numerous "code" limitations in the asserted claims. In each instance, RecogniCorp  
 23 says discovery is required before compliant ICs can be provided. The alleged need for  
 24 "discovery" is not a proper basis for failing to comply with the requirements of L.P.R. 120.  
 25 Moreover, the excuse that "discovery is needed" is particularly inappropriate in this case,  
 26 because the plaintiff has not even served any discovery requests.

1       RecogniCorp has asserted all claims (claims 1-42) of the '303 patent against all of the  
 2 accused Nintendo products. Exh. 2, p. 2. Claim 1 reads as follows, with the elements that are  
 3 not mapped to the accused instrumentalities emphasized:

4           **Claim 1.** A method for creating a composite image, comprising:

5           displaying facial feature images on a first area of a first display via a  
 6 first device associated with the first display, wherein the facial feature  
 7 images are associated with facial feature element codes;

8           selecting a facial feature image from the first area of the first display  
 9 via a user interface associated with the first device, wherein the first  
 10 device incorporates the selected facial feature image into a composite  
 11 image on a second area of the first display, wherein the composite  
 12 image is associated with a composite facial image code having at least  
 13 a facial feature element code; and

14           reproducing the composite image on a second display

15           based on the composite facial image code.

16       Exh. 1, Col. 12. All the independent claims, 1, 16, 23, 29, and 36, include both of these  
 17 limitations of "facial feature element codes" and a "composite facial image code having at least a  
 18 facial feature element code." Since every independent claim includes these limitations, they are  
 19 also effectively present in all the dependent claims. Therefore, RecogniCorp's inadequate  
 20 infringement contentions affect all the claims in this case.

21       Further, in RecogniCorp's Contentions regarding Nintendo's 3DS and 3DS XL  
 22 (collectively, "3DS"), all the independent claims of the '303 patent require a first and second area  
 23 of a "first display" or "first screen," but RecogniCorp alleges that the *two separate screens* of the  
 24 3DS meet this requirement based on nothing but "information and belief." Exh. 5, p. 2. The  
 25 "first screen" limitation in claim 1 (emphasized above - "first area of the first display" and  
 26 "second area of the first display) is illustrative.

27       In addition, for every independent claim, there is a dependent claim (specifically, claims  
 28 10, 19, 24, 32, and 38) that requires a "code factor." RecogniCorp has also failed to indicate  
 29

1 specifically where the "code factor" is allegedly found in any accused device or method. Claim  
 2 10 of the patent, which is representative, is reproduced below:

3           **Claim 10.** The method of claim 1, wherein the composite image code  
 4 includes or is based on one or more code factors.

5 Exh. 1, Col. 13.

6           ***The "facial feature element codes" limitation.***

7           RecogniCorp's claim charts (hereinafter referred to as "claim charts") give no support to  
 8 this limitation. They instead parrot the claim language ("In the Accused Instrumentalities, the  
 9 facial feature images are associated with facial feature element codes") and add this statement:  
 10 "On information and belief, a review of Defendant's information provided in discovery,  
 11 including but not limited to technical specifications and/or source code, will confirm that the  
 12 facial feature images are associated with facial feature element codes." Exh. 3, p. 2 *et seq.* This  
 13 statement does not provide any information besides the claim language itself. It is inappropriate  
 14 to "simply mimic[] the language of the claim," providing "no further information to defendants  
 15 than the claim language itself."). *Network Caching Technology, LLC v. Novell, Inc.*, 2002 U.S.  
 16 Dist. LEXIS 26098, \*18, (N.D. Cal. Aug. 13, 2002) ("*Network Caching I*")<sup>1</sup>.

17           Since RecogniCorp is apparently in possession of a Wii console, a Wii U, and a Nintendo  
 18 3DS and 3DS XL,<sup>2</sup> it should be able to reverse engineer them and state specifically where and  
 19 what the "codes" and "code factors" discussed herein are. *Network Caching I*, 2002 U.S. Dist.  
 20 LEXIS 26098, at \*5 (Reverse engineering or its equivalent is required for Infringement  
 21 Contentions).

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23           <sup>1</sup> Due to the amount of precedent available to interpret and apply the Local Patent Rules, this  
 24 Court has stated that cases interpreting the local patent rules for the Northern District of  
 25 California" are "useful" because of the similarity between the language of the local patent rules  
 for in both Districts. *Allvoice Developments US, LLC v. Microsoft Corp.*, No. 10-02102, p.2,  
 FN. 2 (W.D. Wash., December 27, 2012).

26           <sup>2</sup> As evidenced by the "screenshots" in RecogniCorp's Infringement Contentions.

1           ***The "composite facial image code" limitation.***

2           As with the facial feature element codes limitation, RecogniCorp's claim charts also fail  
 3 to support this limitation, but again simply parrot the claim language and state that "[o]n  
 4 information and belief, a review of Defendant's information provided in discovery, including but  
 5 not limited to technical specifications and/or source code, will confirm that the facial feature  
 6 images are associated with facial feature element codes." Exh. 3, p. 3, *et seq.* This does not  
 7 even mention the "composite facial image codes", but again refers, apparently in error, to the  
 8 "facial feature element codes" limitation.

9           Accordingly, RecogniCorp's claim charts regarding this element do not comply with the  
 10 Local Patent Rules, which are designed to "provide defendants' with notice of infringement  
 11 beyond that which is provided by the mere language of the patents themselves." *Network*  
 12 *Caching Tech., LLC v. Novell, Inc.*, 2003 U.S. Dist. LEXIS 9881, \*13 (N.D. Cal. Mar. 21, 2003)  
 13 ("*Network Caching II*").

14           ***The "first screen" limitation.***

15           RecogniCorp's claim charts give no support to this limitation as to the 3DS. Specifically,  
 16 RecogniCorp alleges that: "On information and belief, the two portions of the screen operate  
 17 utilizing substantial shared electronics, circuitry, processor(s) and/or software." Exh. 5, p. 2.  
 18 This is tantamount to an admission that RecogniCorp did no investigation whatsoever of the 3DS  
 19 as to this element, because the alleged "shared electronics" and "circuitry" (if true) would be  
 20 readily apparent as soon as the 3DS is taken apart. Shared electronics and circuitry are physical  
 21 things, and if RecogniCorp had performed "reverse engineering or its equivalent," it could have  
 22 included photographs of the product with the alleged shared electronics and circuitry highlighted  
 23 and made its allegation *not* "on information and belief" but on facts discovered after due  
 24 diligence.

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1           ***The “code factor” limitation.***

2           As with both the "facial feature element code" and "composite facial image code"  
 3 limitations, RecogniCorp's claim charts also fail to support the "code factor" limitation, but again  
 4 simply parrot the claim language and reiterate that "on information and belief," discovery will  
 5 allow RecogniCorp to "confirm" the presence of composite facial image codes.<sup>3</sup> Exh. 3, p. 10 *et*  
 6 *seq.* Again, this statement does not provide Nintendo or the Court any more information than the  
 7 claim language itself.

8           **III. ARGUMENT**

9           **A. Portions Of RecogniCorp's Contentions Should Be Stricken For**  
 10           **Failure to Show Where Each Limitation Of Each Asserted Claim Is**  
             **Found In The Accused Products.**

11          This district's Local Patent Rules require RecogniCorp to "identify[] specifically where  
 12 each element of each Asserted Claim is found within each Accused Device." L.P.R. 120(c). The  
 13 rules were "designed to require parties to crystallize their theories of the case early in the  
 14 litigation and to adhere to those theories once they have been disclosed." *REC Software USA*,  
 15 2012 U.S. Dist. LEXIS at \*8 (*quoting Nova Measuring Instruments Ltd. v. Nanometrics, Inc.*,  
 16 417 F. Supp. 2d 1121, 1123 (N.D. Cal. 2006)). The specificity required is such that the patent  
 17 holder must go beyond simply parroting the claim language in its charts. *Network Caching I*,  
 18 2002 U.S. Dist. LEXIS 26098, \*18. In *Network Caching I*, Judge Walker held that the minimum  
 19 level of prefilng investigation required by Rule 11 (which also sets the standard for the level of  
 20 detail required by the L.P.R.s) is "reverse engineering or its equivalent." *Id.* at \*5.

21          RecogniCorp has failed to meet these requirements because its ICs fail to identify  
 22 specifically where each claim limitation is found in each accused product. The contentions have  
 23 far less detail than would be provided by "reverse engineering or its equivalent," but instead ask  
 24 the Court and Nintendo to assume that key claim limitations are present. In the limitations  
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26          <sup>3</sup> Beyond this, RecogniCorp's chart simply paraphrases the claim language.

1 specifically identified above, RecogniCorp's ICs fail to even discuss where or how the  
 2 limitations are met, and instead merely parrot the claim language.

3 Here, RecogniCorp's ICs speculate that "on information and belief" the "code" elements  
 4 must be in Nintendo's devices, and that further discovery will "confirm" the contentions. The  
 5 phrase "[o]n information and belief, a review of Defendant's information provided in discovery,  
 6 including but not limited to technical specifications and/or source code, will confirm that . . ."  
 7 appears in Plaintiff's contentions a total of *93 times*. Such a wholesale copying and pasting of  
 8 contentions indicates that RecogniCorp did not perform a serious investigation into Nintendo's  
 9 alleged infringement. *Theranos, Inc. v. Fuisz Pharma LLC*, 2012 U.S. Dist. LEXIS 172160, \*17  
 10 (N.D. Cal. Nov. 30, 2012) ("Fuisz copies and pastes these [on information and belief] responses  
 11 throughout its Contentions, further evidencing the presumptive nature of their claims.").

12 RecogniCorp's ICs suggest that discovery must be conducted before it can state whether  
 13 any of the "code" limitations can actually be found in any Nintendo products. Apparently,  
 14 RecogniCorp intends to reserve for itself the opportunity to amend its contentions without regard  
 15 to whether the Local Patent Rules or the Court will allow such amendment.

16 Remarkably, RecogniCorp has not served Nintendo with *any* discovery requests even  
 17 though this case was originally filed (in Oregon) on December 20, 2011, transferred to this Court  
 18 on October 23, 2012, and the Rule 26(f) conference occurred on January 4, 2013. It is simply  
 19 improper for RecogniCorp to shift the burden to Nintendo by claiming it needs discovery before  
 20 it can formulate proper ICs. *Theranos*, 2012 U.S. Dist. LEXIS at \*20 ("By arguing that  
 21 Theranos' information is not publicly available and by offering to amend the Contentions only  
 22 after discovery has occurred, Fuisz is attempting to ignore their obligations and shift the burden  
 23 to Theranos. Such tactic is improper." (*citing Bender v. Maxim Integrated Prods. Inc.*, 2010 U.S.  
 24 Dist. LEXIS 89957, \*8 (N.D. Cal. July 29, 2010)).

25 Further, RecogniCorp is incorrect in implying that it cannot determine whether the  
 26 "code" limitations are present in Nintendo's products without discovery. In its ICs RecogniCorp

1 asserts claims 11, 20, 26, 33, and 40 against all the accused products. These claims all require  
 2 (sometimes using slight language variations) "transmitting the composite image code." Exh. 3, p.  
 3 10 *et seq.* The "source code" or other discovery RecogniCorp claims it needs to determine the  
 4 presence of, for example, the composite image codes, is in fact *not* needed: if the composite  
 5 image code is transmitted as RecogniCorp alleges, that transmission could certainly be detected  
 6 with modern equipment, much like a radio receiver can tune in to a radio broadcast.

7 The '303 patent specifies that the "transmission medium 800 between site A 802 and site  
 8 B 804 may be a telephone line with a set of modems, an Ethernet connection, the Internet or any  
 9 other communication medium suitable for the transfer of data." Exh. 1, Col. 11 ll. 61-65.  
 10 RecogniCorp has been free to investigate such data transmission since at least December 2011,  
 11 but for some reason has apparently been unwilling to do so. It cannot now shift the burden of  
 12 that investigation onto Nintendo without even providing a reason why it believes the code  
 13 limitations to be present in Nintendo's products. *CSR Technology Inc. v. Freescale*  
 14 *Semiconductor*, 2013 U.S. Dist. LEXIS 17502, \*14 (N.D. Cal. Feb. 8, 2013)(*"In addition, that*  
 15 *the processor runs on software is not responsive to Defendant's argument that the ICs fail to*  
 16 *provide any reason why Plaintiff believes the Accused Products perform the claimed method."*).

17 RecogniCorp must do more than simply allege, as it has, that the Accused Devices  
 18 contain a processor and also allege that therefore source code will be needed before it can serve  
 19 Nintendo with adequate contentions. It must also provide a *reason* why it believes Nintendo  
 20 uses "facial feature element codes," "composite facial image codes," and "code factors" as  
 21 alleged.

22       **B. The Court Should Relieve Nintendo Of Its Discovery Obligations  
 23           Under The Local Patent Rules.**

24       This Court has inherent power to relieve Nintendo of its discovery obligations under the  
 25 Local Patent Rules until RecogniCorp complies with L.P.R. 120. Other courts in the Ninth  
 26 Circuit have exercised that power in similar situations. *See, e.g., Bender v. Maxim Integrated*

1    *Prods.*, 2010 U.S. Dist. LEXIS 32115, \*7 (N.D. Cal. Mar. 22, 2010) (noting that “[u]ntil plaintiff  
2    meets the burden of providing infringement contentions compliant with P.L.R. 3-1, the Court  
3    will not order defendant to proceed with discovery”); *Network Caching I.*, 2002 U.S. Dist.  
4    LEXIS 26098 at \*18 (ordering all discovery stayed until the patentee “serves its revised  
5    preliminary contentions.”); *Shared Memory Graphics LLC v. Apple, Inc.*, 2010 U.S. Dist. LEXIS  
6    138868, \*16 (staying discovery until after patent owner complies with P.L.R. 3-1); *Intertrust*  
7    *Technologies Corp.*, 2003 U.S. Dist. LEXIS 22736, \*11 (same).

8           Unless and until RecogniCorp serves ICs that comply with the Local Patent Rules (if it is  
9    allowed to), Nintendo should not be required to produce its invalidity contentions or confidential  
10   technical documents that it would normally be required to produce under L.P.R. 121 and 122,  
11   and in response to any discovery requests. Requiring Nintendo to make its contentions and  
12   disclose its confidential documents before RecogniCorp meets its obligations under the rules  
13   would prejudice Nintendo and also defeat the purpose of the rules in requiring RecogniCorp to  
14   commit to its theories of infringement.

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## IV. CONCLUSION

2 RecogniCorp failed to comply with L.P.R. 120 for the reasons stated above. Accordingly,  
3 Nintendo respectfully requests that the Court Grant Nintendo's Motion to Strike RecogniCorp's  
4 Infringement Contentions, and to relieve Nintendo of discovery obligations pending service of  
5 compliant infringement contentions.

6 Dated this 21<sup>st</sup> day of March, 2013

## **BAKER & MCKENZIE LLP**

/s/ Edward K. Runyan

Edward K. Runyan

Daniel J. O'Connor

Daniel A. Tallitsch

Omar D. Galaria  
PATERSON MACHINERY

BAKER & MCKENZIE (IL)  
200 E. Randolph St., Ste. 5000

300 E Randolph St. Ste. 5000  
Chicago IL 60601

Chicago, IL 60601  
312-861-8000

312-861-8000  
Fax: 312-608-2341

Fax: 312-698-2341

Attorneys for Defendant Nintendo Co., Ltd.

MILLER NASH LLP

/s/ James L. Phillips

James L. Phillips

MILLER NASH LLP

601 Union St

4400 Two Union Square

Seattle , WA 9

206-622-8484

Fax: 622-7485

Attorneys for Defendant Nintendo Co., Ltd.

1                           CERTIFICATE OF SERVICE

2         I hereby certify that on this 21<sup>st</sup> day of March, 2013, I electronically filed and served the  
3     NINTENDO'S MOTION TO STRIKE INFRINGEMENT CONTENTIONS AND TO  
4     RELIEVE NINTENDO OF DISCOVERY OBLIGATIONS; MEMORANDUM OF POINTS  
5     AND AUTHORITIES IN SUPPORT THEREOF with the Clerk of the Court and opposing  
6     counsel using the CM/ECF system.

7         Executed at Seattle, Washington, this 21<sup>st</sup> day of March, 2013.

9                           */s/ James L. Phillips*

10          James L. Phillips

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